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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,528	02/08/2002	Eric Polesuk	P/77-2	2909

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EXAMINER

WILLATT, STEPHANIE L

ART UNIT PAPER NUMBER

3754

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/072,528

Applicant(s)

POLESUK, ERIC

Examiner

Stephanie L. Willatt

Art Unit

3754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Lefebvre.

In Figures 1-4, Lee discloses a pop-up dispenser (10) for dispensing sheets of aluminum foil, as described in column 1, lines 44-48. Each sheet has a lead portion and a trailing portion. The lead portion of the first sheet (30) of aluminum foil extends through a dispensing orifice (elongated opening 14) to an elevation above that of the dispensing unit (10), as shown in Figure 3. The trailing portion of the first foil (30) overlaps the lead portion of the next hair foil to be dispensed, as discussed in column 1, lines 10-19 and column 2, lines 48-51. Withdrawing the first sheet of foil (30) pulls the next sheet, as discussed in column 1, lines 19-23. The withdrawing of the first sheet of foil (30) can be achieved with one hand. The first foil sheet (30) can be applied to a person's hair immediately after being dispensed without any further preparation if the foil sheet is already the proper size for applying to hair. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the foil

sheets dispensed by the dispenser of Lee 3.5 to 6 inches wide, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ (CCPA 1955).

Lee does not disclose the application of foil to a person's hair. Lefebvre discloses the application of foil to a person's hair as prior art in column 1, lines 11-40. It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the foil of Lee to a person's hair, as taught by Lefebvre, in order to highlight only selected strands of hair.

Note: According to MPEP 2111.02, the applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of the applicant's invention if the applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of."

Response to Amendment

3. The declaration under 37 CFR 1.132 filed 30 May 2006 is insufficient to overcome the rejection of claims based upon commercial success as set forth in the last Office action because: (1) Commercial success has not been established and (2) A nexus between the claimed invention and the alleged success has not been established.

MPEP 716.03(b) IV states, "Gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark*,

Inc., 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985), or as to the time period during which the product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988).” Here, the declaration only gives Product Club’s pop-up foil market share for its own market while ignoring the existence of any competitors. Therefore, the declaration does not show this product’s place in the market. What is the market share with respect to other companies selling foil sheets?

MPEP 716.03(b)I states, “Inventor’s opinion as to the purchaser’s reason for buying the product is insufficient to demonstrate a nexus between the sales and the claims invention.” In paragraph 9 of the declaration, the inventor makes statement that the alleged success of the pop-up foil product must be due to the method, since the method is what sets it apart from the prior art. There is no support for the assumption that the alleged success is due to the method, since other factors, such as advertising, could be the cause of the alleged success. Also, the declaration does not make a connection between the claimed method and the alleged success, since the declaration vaguely refers to “the method” and does not refer to specific claimed features. A nexus between the claimed invention and the alleged success has not been established.

The declaration does not show this product’s place in the market, that the product’s profitability is linked to the claimed invention, or that the profitability per unit is anything out of the ordinary in the industry involved.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephanie L. Willatt whose telephone number is (571) 272-4721. The examiner can normally be reached on M-F (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



slw



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